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REMARKS

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because:

(a) it is believed that the amendments of claims 1, 8, 14 and 20, addition of new claim 21, and cancellation of claims 3, 6, 10, and 16 put this application into condition for allowance;

(b) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed;

(c) the amendments of claims 1, 8, 14 and 20, addition of new claim 21 and cancellation of claims 3, 6, 10 and 16 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and/or

(d) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

CERTIFIED DOCUMENTS

Please note that the box "Certified copies of the priority documents have been received" should be checked in the Office Action Summary. The certified copy of Japanese Patent Application No. 2000-162163 was transmitted to the USPTO on December 8, 2000, and a receipt acknowledging receipt of same was received. A copy of the acknowledgment of receipt postcard, the Submission of Certified Copy of Prior Foreign Application in Accordance with the

Requirements of 37 CFR §1.55 and the first page of the priority document are enclosed herewith for the Examiner's convenience.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at pages 2-4, numbered paragraphs 2-19, claims 1-3, 5-10, 12-16, 18-19, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hashimoto et al. (USPN 6,263,201; hereafter, Hashimoto) in view of Admitted Prior Art (APA) and further in view of Miloslavsky (USPN 6,128,646; hereafter, Miloslavsky). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Amended claim 1, and the remaining amended independent claims in similar fashion, is substantially a combination of cancelled claim 3 and claim 1. Two elements in claim 3 ("modification or setting of transmission destination of said received message" and "execution of a program corresponding to said received message") are deleted. This is to clarify the difference with USP 6,662,232.

First, claim 1 includes a limitation as to "a predetermined condition including a requirement including a time when said received message occurred". Therefore, any arbitrary condition is not mentioned in claim 1. On the other hand, as the examiner cited, Miloslavsky discloses that "if an incoming mail is not answered by the selected support person within a predetermined time interval, the mail is re-routed to another qualified and available support person." However, the condition in Miloslavsky is completely different from the requirement including a time when said received message occurred. That is, Miloslavsky cannot handle the time when said received message occurred. Miloslavsky can only handle a time when a first e-mail was sent to the first support person, which is not a different time from a time when said received message occurred, and the time handled by Miloslavsky does not determine and cause any state and result.

Furthermore, the word "standard" has a meaning as "average or normal rather than having special or unusual features" in the Oxford Advanced Learner's dictionary. That is, said received message is passed to the normal destination of said received message in claim 1. However, as the examiner cited, in Miloslavsky, a destination is determined again and the mail

is re-routed to the destination. That is, because the destination to which the message is re-routed is not the "standard" destination of the mail, the destination is determined again.

In addition, the APA does not mention the "requirement including a time when said received message occurred." Furthermore, Hashimoto does not disclose and suggest the "requirement including a time when said received message occurred." This point has been already explained in the remarks in response to the first office action.

Also, Hashimoto teaches that a plurality of messages may be processed. However, Hashimoto does not teach using a requirement relating to a combination of a plurality of messages, as is recited in new claim 21.

Therefore, it is respectfully submitted that amended independent claims 1, 8 and 14, and the claims dependent thereto, are not obvious from the combination of the cited references by the examiner.

Furthermore, it is respectfully submitted that there is no basis and reason to combine the cited references by the examiner.

As the Examiner notes, Hashimoto does not teach the term "fulfilled." In the APA (Japanese Publication No. 10-207795; Inventors, Saito Yukio et al.), the terminology "fulfilled" is utilized as follows: "When a condition preliminary set in a transfer condition storing means 14 by a user is fulfilled, a new message based on the incoming message is prepared, and the mail is transferred to the destination of a mail address preliminarily designated by the user" (emphasis added). Thus, Saito Yukio et al. teaches sharing information with another electronic mail user or FAX and telephone user concerning a received electronic mail, i.e., preventing an increase of traffic due to the transfer of all the received electronic mails by using a remote operation.

In contrast, the present invention, for example, claim 1, recites: " A message processing system comprising: judging means for analyzing a received message, and for judging whether a predetermined condition including a requirement relating to a time when said received message occurred is fulfilled; means for performing a process corresponding to the fulfilled predetermined condition if said judging means judged that said received message fulfilled said predetermined condition, including the requirement relating to the time when said received message occurred; and means for passing said received message to a standard destination of said received message if said judging means judged that said received message did not fulfill said predetermined condition, and wherein said process corresponding to said fulfilled predetermined condition includes at least one of modification or setting of contents of said

received message, modification or setting of display destination of said received message, and modification or setting of recording destination of said received message." (amendment shown). Hence, the present invention, for example, claim 1, and the other independent claims in similar fashion, recites that upon judging that a message is received by a time in a predetermined condition, a process that corresponds to a fulfilled predetermined condition is carried out, and if the message is not received by said time, the message is sent to a standard destination. That is, claim 1 and the other independent claims in similar fashion, sets forth sending a received message to a different destination may be executed according to a time range in which a message occurs.

The APA (Japanese Publication No. 10-207795; Inventors, Saito Yukio et al.) **does not teach sending a received message to a different destination based on a time range during which a message occurs**, but rather **teaches** a transfer processing program **preparing a new message** based on the incoming message **and transferring the new message to a preliminarily designated destination mail address, e.g., a FAX address or a telephone, so that buildup of network traffic is avoided**. Thus, it is respectfully submitted that the APA fails to teach or suggest sending a received message to a different destination according to a time range in which a message occurs.

As noted by the Examiner, Hashimoto also does not teach passing said received message to a standard destination if the received message does not fulfill the predetermined condition. Claim 1 of the present invention, and the other independent claims in similar fashion, recites that if a message is not judged to be received by a time set forth in a predetermined condition, the message is sent to a standard destination. In contrast, Miloslavsky teaches a system routing electronic mail to a best qualified person based on a content analysis, and if the email is not answered within a predetermined time limit, the electronic mail is rerouted to another support person, not a standard destination, as is described in the present invention. Thus, the determination of where an email should be rerouted to in Miloslavsky is different from a determination of where an email should be rerouted to in the present invention.

It is respectfully submitted that the courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490,

1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Thus, since there is no teaching or suggestion of combining Hashimoto with the APA and/or Miloslavsky, and even if combined, such combination would not teach the present invention. Hence, it is respectfully submitted that amended independent claims 1, 8, 14, and 20 are patentable over Hashimoto in view of the APA and/or in view of Miloslavsky. Since claims 2, 5, 7-9, 12-15, 18, and 19 depend from amended independent claims 1, 8, 14 and 20, respectively, claims 2, 5, 7-9, 12-15, 18, and 19 are submitted to be allowable under 35 U.S.C. §103(a) over Hashimoto in view of the APA and/or in view of Miloslavsky for at least the reasons that amended independent claims 1, 8, 14 and 20 are submitted to be allowable under 35 U.S.C. §103(a) over Hashimoto in view of the APA and/or in view of Miloslavsky.

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), limited on other grounds by In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

In the Office Action, at pages 4-5, numbered paragraphs 20-23, claims 4, 11, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hashimoto et al. (USPN 6,263,201; hereafter, Hashimoto) in view of Admitted Prior Art (APA), in view of Miloslavsky (USPN 6,128,646; hereafter, Miloslavsky), and further in view of EM (E-mail reception indication device for E-mail system - changes additional information on E-mail held by server, to unreceived condition or received condition information, if E-mail is unreceived or received by client terminals, respectively). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

It is respectfully submitted that EP 1024446 A1 (Pitney Bowes Limited) teaches that EM, the E-mail reception indication device for an E-mail system is changed to an unreceived

condition if email is not received within a prescribed time period. There is no teaching or suggestion of combining EP 1024446 A1 with Hashimoto. Hence, it is respectfully submitted that any such combination would be a result of hindsight (see above arguments), which is not permitted.

Since claims 4, 11, and 17 depend from amended independent claims 1, 8, and 14, it is respectfully submitted that claims 4, 11 and 17 are submitted to be allowable under 35 U.S.C. §103(a) over Hashimoto et al. (USPN 6,263,201) in view of Admitted Prior Art (APA), in view of Miloslavsky (USPN 6,128,646) for at least the reasons that claims 1, 8 and 14 are submitted to be allowable under 35 U.S.C. §103(a) over Hashimoto et al. (USPN 6,263,201) in view of Admitted Prior Art (APA), in view of Miloslavsky (USPN 6,128,646).

In addition, there is no teaching or suggestion of combining EP 1024446 A1 (Pitney Bowes Limited) with Hashimoto et al. (USPN 6,263,201) and/or Admitted Prior Art (APA) and/or Miloslavsky (USPN 6,128,646).

Hence, claims 4, 11 and 17 are submitted to be allowable under 35 U.S.C. §103(a) over Hashimoto et al. (USPN 6,263,201) in view of Admitted Prior Art (APA), in view of Miloslavsky (USPN 6,128,646), and Pitney (EM).

NEW CLAIMS

New claim 21 recites that the features of the present invention include a message processing system, comprising: a judging unit that analyzes a received message, and judges whether a predetermined condition including a requirement relating to a time when said received message occurred is fulfilled; a unit that performs a process corresponding to the fulfilled predetermined condition if said judging unit judged that said received message fulfilled said predetermined condition, including the requirement relating to the time when said received message occurred; and a passing unit that passes said received message to a standard destination of said received message if said judging means judged that said received message did not fulfill said predetermined condition, and wherein said predetermined condition further includes a requirement relating to a combination of a plurality of messages.

Nothing in the prior art teaches or suggests such. It is submitted that new claim 21 distinguishes over the prior art.

CONCLUSION:

In accordance with the foregoing, claims 3, 6, 10, and 16 have been canceled, claims 1, 8, 14 and 20 have been amended, and new claim 21 has been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 2, 4, 5, 7-9, 11-15, and 17-21 are pending and under consideration. Reconsideration is respectfully requested.

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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